

REMARKS

In the Office Action, the Examiner noted that claims 1-8, 10-26 and 28-32 are pending in the application and that claims 4-8, 10-13, 15-26 and 28-32 are rejected. By this response, claims 1, 4, 10, 15-16 and 18 have been amended, and new claim 33 has been added. Thus, claims 1-8, 10-26 and 28-33 are pending in the application.

Rejections Under 35 U.S.C., §103

Claims 4-8, 10-13, 15-26 and 28-32 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Arends et al.* (US 4, 306,474) in view of *Wittek* (US 1,796,417). Applicant traverses this rejection.

In order for the Examiner to establish a *prima facie* case of obviousness, the Examiner must provide 1) one or more references 2) that were available to the inventor and 3) that teach 4) a suggestion to combine or modify the references, 5) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Here, the Examiner has not provided such a teaching or a suggestion to combine or modify the references.

More particularly, the Examiner notes that *Arends* fails to teach one or more of the guide strips being spaced from the web guide member by at least four thicknesses of the web. The Examiner then asserts that it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide such a spacing between the web guide member and the guide strip of *Arends* in order to be at least four thicknesses of the

web. The Examiner then asserts that the Applicant has not disclosed that the specific spacing provides an advantage, is used for a particular purpose, or solves a stated problem. Applicant traverses this assertion. More particularly, the original filed application at paragraph 57 notes a specific advantage with the spacing in that "...frictional forces...are significantly reduced." Accordingly, such spacing does provide an advantage as asserted in the original filed application. Additionally, the original filed application provides another advantage at paragraph 52 where, "...little or no contact occurs between guide strip 198 and such web during a processing operation."

Furthermore, by stating that it would have been an obvious matter of design choice, the Examiner has merely made an unsupported statement that aspects of the invention are obvious, or are of "basic knowledge" or "common sense" to one of ordinary skill in the art. Such an unsupported statement is generally insufficient. Applicant requests additional factual findings which underlie the Examiner's legal determination of obviousness. To support such factual finding, Applicant requests that the Examiner provide an affidavit or substantive evidence of such factual findings.

Additionally, the Examiner has asserted that one of ordinary skill in the art would have expected the spacing of *Arends* and Applicant's invention to perform equally well with either arrangement since both arrangements would perform the same function. Applicant traverses this assertion. The Examiner further asserts that it has held that discovering an optimum value of a result effective variable involves only routine skill in the art. Applicant traverses this assertion and asserts that the Examiner has not provided a suggestion to

combine or modify the references, and that this is not merely the discovery of an optimum value of a result effective variable involving routine skill in the art. Instead, Applicant has provided a non-obvious solution that reduces frictional forces which then leads to increased operating speeds. Here, the Examiner has failed to provide a suggestion to modify the references. It is well established that an invention is not obvious where an Examiner has failed to provide a suggestion even if the prior art "could" have been combined (or modified). Nowhere does the prior art appear to provide a motivation for spacing the guide strips in the manner claimed in order to reduce frictional forces (which increases operating speeds). Without such suggestion or motivation, the Examiner has not established a *prima facie* case of obviousness. Accordingly, the rejection to the above-referenced claims under 35 U.S.C. § 103(a) is believed to be overcome. Accordingly, action to that end is respectfully requested.

Withdrawal of this rejection is respectfully requested.

Allowed and Allowable Claims

Applicant respectfully thanks the Examiner for the allowance of claims 1-3. Furthermore, claim 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. §103(a), as stated in the instant Office Action and to include all of the limitations of the base claim and any intervening claims.

Applicant respectfully acknowledges the Examiner's allowance of claims 1-3, and the allowability of claim 14 (and put in independent form). Applicant reserves the right to

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later place claims 1-3 and 14 in such allowed form before the Examiner. However, independent claims 1, 4, 10, and 15 have been amended to recite variously a "roller feed release mechanism" or a "drive release mechanism" in substitution for the "knock lever mechanism". Such amended claims are still believed to be allowable over the prior art of record and action to that end is respectfully requested.

CONCLUSION

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

Respectfully submitted,

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